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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,993

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Achim Luft

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EXAMINER

NGUYEN, PHUNG HOANG JOSEPH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,993	Applicant(s) LUFT ET AL.	
	Examiner PHUNG-HOANG J. NGUYEN	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/30/2006 and 2/28/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13-24 of the present application (#10/573,993) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-22 of U.S. invention application number 10/573,947. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-24 of the present invention are similar in scope to claims 13-24 of US Patent No. 6,370,120 with obvious wording variation with broader limitations. For example:

Claim 13 of the present invention application (Serial # 10/573,993)	Claim 12 of US application (Serial # 10/573,974)
<p>A method for setting up a communication link from a first telecommunication device to a second telecommunication device via a telecommunication network, comprising:</p> <p>storing at least one multimedia object in the second telecommunication device, each multimedia object having a corresponding reference number;</p> <p>specifying an allocation map, having at least one data record, each indicating allocation of a specific call recipient to a specific reference number of a specific multimedia object;</p> <p>sending a connection setup request from the first telecommunication device allocated to a user to the telecommunication network, which request indicates that a communication link is to be set up from the first telecommunication device to the second telecommunication device allocated to a second telecommunication user;</p>	<p>A method for setting up a communication link from a first telecommunication device over a telecommunication network to a second telecommunication device, comprising:</p> <p>storing in the telecommunication network multimedia objects assigned to a first telecommunication subscriber, each multimedia object having a corresponding reference number;</p> <p>defining an assignment mapping using at least one data set which specifies assignment of a specific call recipient to a specific reference number of a specific multimedia object;</p> <p>sending a connection setup request from the telecommunication device assigned to the first telecommunication subscriber to the telecommunication network which specifies that a communication link from the first telecommunication device to a second telecommunication device assigned to a second telecommunication</p>

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<p>determining the corresponding reference number for the first telecommunication user when communicating with the second telecommunication user, using the allocation map;</p> <p>transmitting a call signal to the second telecommunication device, together with display information that is a function of the corresponding reference number; and</p> <p>playing by the second telecommunication device a corresponding multimedia object, included in the at least one multimedia object stored in the second telecommunication device and matching the corresponding reference number, based on the display information.</p>	<p>subscriber is to be set up;</p> <p>determining the corresponding reference number specified for the second telecommunication subscriber based on the assignment mapping;</p> <p>transmitting, from the telecommunication network to the second telecommunication device, an identified multimedia object assigned to the corresponding reference number;</p> <p>playing back the identified multimedia object on the second telecommunication device.</p>
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From the above evidence, it is clear that the claim limitations of the present invention are clearly covered by the limitations of the US application number 10/573,974.

DETAILED ACTION

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 24 recites “a method in accordance with one of claims 13 to 23”.

Therefore, it is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For the purpose of continuous examination, examiner interprets as it depends on independent claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13, 17, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibao (EP 1 289 241 A1).

As to claims 13, 17 and 24, Shibao teaches a method for setting up a communication link (*i.e., line connection, col. 5, line 12 and fig 1, line connection between two transceivers of calling and called station*) from a first telecommunication device (*Fig. 1, calling-end terminal station 3*) to a second telecommunication device (*Fig. 1, called-end terminal station 5*) via a telecommunication network (*Fig. 1 communication network 7*), comprising:

storing at least one multimedia object (*i.e., animation or other types of moving pictures adds to the traffic, col. 4, lines 15-18*), in the second telecommunication device (*col. 2, lines 46-51: the transmitted data and calling party information may be transmitted from the calling-end device to the called-end device directly over the communications network to store calling party information in advance. In this case, the calling party information server transmits calling party information to the called-end device in response to an*

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instruction from calling-end device. This indicates that the second telecommunication device does store the information) each multimedia object having a corresponding reference number (i.e., When the animation as calling party information C11 and C21 (of figs. 1 and 4) is stored, the calling party information DB91 stores frames in bitmap format, col. 13, lines 8-16; Or when the animation is stored, may be stored using geometric patterns, Col. 13, lines 17-35. This indicates that there is a reference number attached to frame or bitmap).

specifying an allocation map, having at least one data record, each indicating allocation of a specific call recipient to a specific reference number of a specific multimedia object (*i.e., calling party information server 9 having calling party information DB91 with the assignment mapping list, fig. 1*);

sending a connection setup request (*i.e., a call-up, col. 1, line 11 and also steps 1 and 2 of fig. 4*) from the first telecommunication device (Fig. 1, *calling-end terminal station 3*) allocated to a first telecommunication user (see Abstract) to the telecommunication network, which request indicates that a communication link (*i.e., line connection, col. 5, line 12 and fig 1, line connection between two transceivers of calling and called station*) from the first telecommunication device (Fig. 1, *called-end terminal station 5*) to the second telecommunication device allocated to a second telecommunication user (*col. 1, line 7*);

determining the corresponding reference number (*i.e., information that matches the two numbers, Fig. 1, labels 92, 93 and 94; col. 15, lines 44-52*) for the first telecommunication user when communicating with the second

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telecommunication user, using the allocation map (*i.e., having calling party information DB91 with the assignment mapping list, fig. 1*)

transmitting a call signal (*i.e., call-up, col. 11, line 40*) to the second telecommunication device, together with display information (*i.e., displaying characters, images and animation, col. 1, line 55*) that is a function of the corresponding reference number (Fig. 1, *calling party information 94*); and

playing by the second telecommunication device a corresponding multimedia object, included in the at least one multimedia object (*i.e., animation or other types of moving pictures adds to the traffic, col. 4, lines 15-18*), stored in the second telecommunication device and matching the corresponding reference number, based on the display information (*fig. 2 step 14, col. 16, lines 19-28 indicates that display information is set up in advance*).

As to claim 14, Shibao teaches: storing the allocation map in the first telecommunication device (*i.e., calling party information server 9 having calling party information DB91 with the assignment mapping list, fig. 1*); and transmitting, by the first telecommunication device to the telecommunication network (*i.e., transmitting over a packet network, col. 22, line 25*), the corresponding reference number of the corresponding multimedia object (*i.e., When the animation as calling party information C11 and C21 (of figs. 1 and 4) is stored, the calling party information DB91 stores frames in bitmap format, col. 13, lines 8-16; Or when the animation is stored, may be stored using geometric patterns, Col. 13, lines 17-35. This indicates that there is a reference number attached to frame or bitmap*) for the first telecommunication user when

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communicating with the second telecommunication user, and wherein said transmitting of the display information (*i.e., displaying characters, images and animation, col. 1, line 55*) includes the telecommunication network sending the display information that is a function of the corresponding reference number to the second telecommunication device (*i.e., the calling end determines calling party information and transmits transmitted data representative of the calling party information to the called-end device. The transmitted data may be the calling party information itself or data which allows for identifying the calling party information, such as, identification code (col. 2, lines 34- 39).*

As to claim 15, Shibao teaches storing the allocation map (*i.e., information DB91 with the assignment mapping list, fig. 1*); in the telecommunication network, and wherein said determining of the corresponding reference number is performed in the telecommunication network (*i.e., As the calling party information is transmitted over the communications network 7 and received by the calling-party-information receiving unit 54 in the called-end terminal station 5 (S8), col. 15 60-col. 16, line 3*).

As to claim 16, Shibao teaches said determining provides, in the event of a call recipient being selected for whom there is no data record in the allocation map, a predefined reference number of a predefined multimedia object (*i.e., there is stored no calling party information corresponding to both in a received-calling-party information DB 59e in the called-end terminal station 5e, col. 26, lines 23-24*).

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As to claims 18-19, Shibao teaches: comparing the display information transmitted to the second telecommunication device with any reference number of any multimedia object allocated to the first telecommunication user stored in the second telecommunication device (*i.e., simplifies the configuration of the called end terminal station 5 in comparison with the called-end terminal station 5 establishing connection to both the calling-end terminal station 3 and the calling party information server 9, col. 19, lines 4-8*).

transmitting an update request message from the second telecommunication device to the telecommunication network to request a network-stored multimedia object corresponding to the display information if said comparing produces a negative result (*i.e., As the managing method of calling party information upon modification, one of the two is employed: whether to reproduce new calling party information in response to a user's instruction and whether to save both., col. 27, line 49-52*).

As to claim 20, Shibao teaches maintaining a storage entitlement indicator indicating whether the network-stored multimedia object of the first telecommunication user is allowed to be stored at the second telecommunication device (*i.e., storage means for storing calling party information enabling a called-end device to alert to an incoming call; and calling party information transmitting means for reading out the calling party information from the storage means based on an instruction from a calling-end device and transmitting the readout calling party information to the called-end device before the called-end device accepts the call, col. 8 lines 6-14*).

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As to claim 21, Shibao teaches the at least one multimedia object includes at least one of an image and tone information (*i.e., sounds or images or alert animation; col. 10, line 57*).

As to claim 22, Shibao teaches the at least one of the first and second telecommunication devices is one of a mobile radio device, a mobile telephone, a computer having a radio module and a wired telephone (*col. 10, lines 50-55*).

As to claim 23, Shibao teaches the network is at least one of a public fixed line telephone network (*col. 10, lines 31-33 and 55*) and a mobile radio network which operating according to at least one of the Global System for mobile communication (*col. 11, line 11*) and UMTS.

INQUIRY

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUNG-HOANG J. NGUYEN whose telephone number is (571)270-1949. The examiner can normally be reached on Monday to Thursday, 8:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571 272 7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 19, 2008

/Phung-Hoang J Nguyen/
Examiner, Art Unit 2614

/Curtis Kuntz/

Supervisory Patent Examiner, Art Unit 2614